

## REMARKS/ARGUMENTS

In response to a Notice of Non-Compliant Amendment dated December 28, 2006 (“Notice”), the Applicant is submitting this Reply. The Notice stated that the amendments of the Response filed on November 8, 2006 (“Previous Response”) were not in compliance with 37 C.F.R. § 1.121 (*i.e.*, “a complete listing of all the claims is not present”). Although no amendments were made in the Previous Response, the Applicants are resubmitting the Previous Response with a supplemented Listing of Claims that includes the withdrawn claims, which were omitted from the Previous Response.

Claims 1-9 and 18-20 remain pending for further prosecution. None of the claims has been amended.

### Allowable Subject Matter

Claim 19 has been “objected to as being dependent upon a rejected claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Claim 19 has already been amended to include “all of the limitations of the base claim and any intervening claims” in the previously submitted Amendment and Reply that was filed on April 10, 2006. Thus, this objection has been erroneously made and, accordingly, the Applicants respectfully submit claim 19 is allowable as previously amended.

### Withdrawal of Final Rejection

The Applicants respectfully submit that the current Office action was prematurely made a “final” Office action and, should the claims not be deemed allowable, request the withdrawal of the finality of the rejection. “If, on request by applicant for reconsideration, the primary examiner finds the final rejection to have been premature, he or she should withdraw the finality of the rejection.” Manual of Patent Examining Procedure (MPEP), Rev. 5, August 2006, § 706.07(d), page 700-85.

The current Office action was made “final” because allegedly the “Applicant’s amendment necessitated the new ground(s) of rejection presented in this Office action.” In response to the previous Office action, the Applicants made only two amendments:

- 1) a first amendment to claim 19, which was simply for complying with an objection in which the claim was deemed allowable; and
- 2) a second amendment to claim 18, which was “only to clarify that the support struts provide rigidity to the cast base” (*i.e.*, “the support struts providing rigidity to said cast base”).

Furthermore, it is noted that claim 1, which is the only other independent claim, was not amended.

The Hikake Publication was introduced for the first time in the current office action, and is being relied on as the primary reference for rejecting the pending claims. The Hikake Publication replaces U.S. Patent No. 6,858,839 to Anderson *et al.* (“Anderson”), which was previously relied on for rejecting the pending claims. It is apparent that none of the two amendments submitted in the previous response caused the Examiner to perform a new search for replacing Anderson. For example, the amendment to claim 19 is irrelevant to the new search because the claim had already been deemed allowable. Similarly, the amendment to claim 18 was simply a clarification amendment.

Thus, the Applicants respectfully request that the finality of the current office action should be withdrawn, if the claims are not allowed.

### **Rejection of claims 1-3 and 5-9 under 35 U.S.C. § 102**

Claims 1-3 and 5-9 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0032817 A1 to Hikake *et al.* (“the Hikake Publication”).

The Applicants respectfully submit that the Hikake Publication is not prior art under 35 U.S.C. § 102(e). For a reference that “resulted from, or claimed the benefit of, an international application, the following must be determined:

- (1) If the international application meets the following three conditions:
  - (a) an international filing date on or after November 29, 2000;
  - (b) designated the United States; and
  - (c) published under PCT Article 21(2) in English,then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e). ...

- (2) If the international application was filed on or after November 28, 2000, but did **not** designate the United States or was **not** published in English under PCT Article 21(2), do **not** treat the international filing date as a U.S. filing date for prior art purposes.

Manual of Patent Examining Procedure (“MPEP”), Rev. 5, August 2006, § 706.02(f)(1)(I), pages 700-29 – 700-30, (underlining added).

The Hikake Publication issued as U.S. Patent No. 6,993,825 (“the Hikake Patent”), which is attached as Appendix A for the convenience of the Examiner. As listed on the front page of the Hikake Patent, the Hikake Publication was published by WIPO as PCT Publication No. WO03/018343 (“the PCT Publication”) on March 6, 2003. However, the PCT Publication was published in Japanese, **not in English**. A copy of the PCT Publication, in Japanese, is attached as Appendix B for the convenience of the Examiner.

Thus, the Hikake Publication is not prior art under 35 U.S.C. § 102(e) because the PCT Publication was not published in English. Furthermore, even if the Hikake Publication were to qualify as prior art, the Applicants believe they have evidence for supporting a 37 C.F.R. § 1.131 Declaration to show a prior invention.

### **Rejection of claims 4, 18, and 20 under 35 U.S.C. § 103**

Claims 4, 18, and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Hikake Publication as applied to claim 1 above, and further in view of U.S. Patent No. 6,771,437 B1 to Willis (“Willis”).

Claims 4, 18, and 20 are patentable over the Hikake Publication in view of Willis at least because the Hikake Publication is not prior art under 35 U.S.C. § 102(e), as explained above in reference to claims 1-3 and 5-9.

### **Conclusion**

It is the Applicants’ belief that all of the claims are now in condition for allowance and action towards that effect is respectfully requested. If there are any matters which may be resolved or clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney at the number indicated.

Application No. 10/626,291

Response dated January 10, 2007

Reply to Notice of Non-Compliant Amendment of December 28, 2006

It is believed that no fees are due; however, should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47080-00047USPT.

Respectfully submitted,



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